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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/828,506

04/19/2004

Len Rothbaum

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EXAMINER

LASTRA, DANIEL

ART UNIT

PAPER NUMBER

3688

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/828,506	<b>Applicant(s)</b> ROTHBAUM, LEN	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-19 have been examined. Application 10/828,506 (ADVERTISING SYSTEM AND METHOD) has a filing date 04/19/2004 Claims Priority from Provisional Application 60463888, filed 04/18/2003.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus).

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***Claim Objections***

3. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. For purpose of art rejection, said claim would be made dependent of claim 9.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11, 12 and 14-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Stewart (US 2002/0136377).

Claim 1, Stewart teaches:

An advertising presentation system for use in connection with accounts, comprising:

an advertising server for presenting an advertisement to an account user in conjunction with access to the account or in conjunction with completion of a transaction (see paragraph 8).

Claim 2, Stewart teaches:

wherein said advertisement is presented prior to access to the account or prior to completion of the transaction (see paragraph 25).

Claim 3, Stewart teaches:

wherein the account user is a prepaid telephone card holder (see paragraph 6).

Claim 4, Stewart teaches:

wherein said advertisement is presented prior to completion of a telephone call the user is attempting to make by use of the prepaid telephone card (see paragraph 6).

Claim 5, Stewart teaches:

A method of providing advertising, comprising:

providing an account user with a manner of accessing an account (see paragraph 8);

presenting an advertisement to the user when the user attempts to access the account (see paragraph 8).

Claim 6, Stewart teaches:

wherein the presenting step presents the advertisement to the user before allowing access to the account (see paragraph 10).

Claim 7, Stewart teaches:

wherein the account is a telephone calling account (see paragraph 6).

Claim 8, Stewart teaches:

wherein the account is a telephone calling account and the manner of access is a prepaid calling card (see paragraph 6).

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Claim 9, Stewart teaches:

A calling card, comprising:

plural cards presented as a unit, wherein at least one of said cards comprises a calling card, and at least one comprises a services access card (see paragraph 6).

Claim 11, Stewart teaches:

A method of providing advertising and telecommunication services to a consumer, comprising:

presenting an advertisement to the consumer (see paragraph 8); and  
offering the consumer a service free of charge in exchange for the consumer having listened to or observed the advertisement (see paragraph 8).

Claim 12, Stewart teaches:

wherein the service comprises a telephone call (see paragraph 8).

Claim 14, Stewart teaches:

wherein the telephone call is allowed to be placed to a number desired by the customer to any valid phone number (see paragraph 8).

Claim 15, Stewart teaches:

wherein the advertisement is an audio advertisement (see paragraph 10).

Claim 16, Stewart teaches:

wherein the advertisement is an audio-visual advertisement (see paragraph 10).

Claim 17, Stewart teaches:

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wherein the advertisement is a visual advertisement (see paragraph 10).

Claim 18, Stewart teaches:

wherein the service comprises access to a computer network (see paragraphs 21-22).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 2002/0136377).

Claim 10, Stewart does not expressly teach:

wherein the number of said plural cards is three. However, Official Notice is taken that it is old and well known in the communication art for a user to carry a plurality of prepaid or calling cards. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Stewart's users would carry a plurality of cards in order to place phone calls, as it is old and well known to do so.

Claim 13, Stewart does not teach:

wherein the telephone call is not allowed to exceed a timed duration. However, Official Notice is taken that it is old and well known in the communication art to have a duration limit for a telephone call based upon a prepaid

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store value. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Stewart's telephone call would have a duration based upon a stored prepaid value, as it is old and well known to do so.

Claim 19, Stewart does not teach:

wherein the service comprises access to an email service. However, Official Notice is taken that it is old and well known in the communication art to allow users to connect to email services using wireless phones. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Stewart's wireless phone would allow users to connect to email services, as it is old and well known to do so.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
September 23, 2008